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EXAMINER

JACOBS, LASHONDA T

ART UNIT PAPER NUMBER

2157

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/090,893

Applicant(s)

CAMERON ET AL.

Examiner

LaShonda T. Jacobs

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11,21-26,28-35,37 and 38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11,21-26,28-35,37 and 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/1/2005 9/1
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This Office Action is response to Applicants' Election to Restriction Requirement on October 26, 2005. Applicants' elected Group I. Claims 1-11, 21-26, 28-35, 37 and 38 are presented for examination.

Double Patenting

1. Claims 1-11, 21-26, 28-35, 37 and 38 of this application conflict with claims 1-32 of Application No. 10/091,203. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-11, 21-26, 28-35, 37 and 38 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-32 of copending Application No. 10/090,203. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

(‘203.) Claim 1. A system comprising:

a server configured to store documents in one or more server formats, wherein the documents are available to one or more devices via a network, wherein the server is configured to generate a small device document in a small device format from a document in a server format, wherein, to generate a small device document in a small device format from a document in a server format, the server is further configured to exclude one or more formats for content of the document in the server format from the small device document; and

wherein the server is further configured to provide the small device document to a small device coupled to the server; the small device, wherein the small device is configured to:

modify the small device document to produce a modified version of the small device document; and

provide the modified version of the small device document to the server; wherein the server is further configured to generate a modified version of the document in the server format from the modified version of the small device document, wherein, to generate a modified version of the document in the server format from the modified version of the small device document, the server is further configured to restore the one or more formats for content of the document in the server format excluded from the small device document.

('203 Claim 7) configured to resolve differences between the modified version of the document in the server format and another modified version of the document in the server format to generate a synchronized version of the document in the server format.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See MPEP § 804.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims **1-11, 21-26, 28-35, 37 and 38** are rejected under 35 U.S.C. 102(e) as being anticipated by Mendez et al (hereinafter, "Mendez", U.S. Pat. No. 5,961,590).

As per claim **1**, Mendez teaches a system comprising:

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- a server comprising a document in a format supported by the server, wherein the document is available to one or more devices via a network (col. 4, lines 57-67 and col. 5. lines 26-47);
- a small device configured to couple to the server (col. 4, lines 57-67 and col. 5. lines 26-47);
- wherein the server is configured to generate a small device document in a format supported by the small device from the document in the format supported by the server (col. 4, lines 57-67 and col. 5. lines 26-47);
- wherein the small device is further configured to modify the small device document (col. 4, lines 21-45); and
- wherein the server is further configured to synchronize the document in the format supported by the server with a modified version of the small device document on the small device (col. 4, lines 46-57 and col. 8, lines 12-26).

As per claim 2, Mendez teaches:

- wherein the document in the format supported by the server is an office productivity document (col. 6, lines 47-64 and col. 8, lines 1-10).

As per claim 3, Mendez teaches:

- wherein, to generate a small device document in a format supported by the small device from the document in the format supported by the server the server is further configured to exclude one or more formats for content of the document in the format supported by the server from the small device document (col. 17, lines 14-34).

As per claim 4, Mendez teaches:

- wherein, to synchronize the document in the format supported by the server with a modified version of the small device document on the small device, the server is further configured to restore one or more formats for content of the document in the format supported by the server excluded from the small device document (col. 17, lines 14-34).

As per claim 5, Mendez teaches wherein, to synchronize the document in the format supported by the server with a modified version of the small device document on the small device, the server is further configured to:

- determine one or more formats for content of the modified version of the small device document to be merged with the document in the format supported by the server (col. 2, lines 49-67); and
- merge the content of the modified version of the small device document into the document in the format supported by the server in accordance with the determined one or more formats for the content (col. 2, lines 49-67).

As per claim 6, Mendez teaches wherein, to synchronize the document in the format supported by the server with a modified version of the small device document on the small device, the server is further configured to:

- compare modified content of the modified version of the small device document to corresponding content of the document in the format supported by the server to determine one or more formats for the modified content of the modified version of the small device document to be merged with the document in the format supported by the server (col. 6, lines 35-42 and col. 10, lines 3-17); and

- merge the modified content of the modified version of the small device document into the document in the format supported by the server in accordance with the determined one or more formats for the modified content (col. 2, lines 49-67).

As per claim 7, Mendez teaches:

- wherein, to synchronize the document in the format supported by the server with a modified version of the small device document on the small device, the server is further configured to generate a synchronized version of the document in the format supported by the server from the document in the format supported by the server and the modified version of the document (col. 5, lines 14-43).

As per claim 8, Mendez teaches wherein, to synchronize the document in the format supported by the server with the modified version of the small device document, the server is further configured to:

- determine one or more differences between the modified version of the small device document and the document in the format supported by the server (col. 8, lines 27-48);
and
- merge the determine one or more differences with content of the document in the format supported by the server to generate a synchronized version of the document in the format supported by the server (col. 2, lines 49-67).

As per claim 9, Mendez teaches wherein, to determine one or more differences between the modified version of the small device document and the document in the format supported by the server, the server is further configured to:

- generate a modified document in the format supported by the server from the modified version of the small device document (col. 6, lines 35-42); and
- compare the modified document in the format supported by the server to the document in the format supported by the server (col. 10, lines 3-17).

As per claim **10**, Mendez teaches, wherein, to synchronize the document in the format supported by the server with the modified version of the small device document, the server is further configured to:

- generate a modified document in an interim format from the modified version of the small device document (col. 11, lines 19-29, col. 20, lines 60-67 and col. 22, lines 1-6);
- generate a document in the interim format from the document in the format supported by the server (col. 5, lines 45-64 and col. 6, lines 19-33);
- determine one or more differences between the modified document in the interim format and the document in the interim format (col. 8, lines 35-47); and
- merge the determined one or more differences with content of the document in the interim format to generate a synchronized version of the document in the interim format (col. 2, lines 49-67).

As per claim **11**, Mendez further teaches:

- wherein the server is configured to generate a synchronized version of the document in the format supported by the server from the synchronized version of the document in the interim format (col. 6, lines 19-33).

As per claims **21** and **30**, Mendez teaches a method and an article of manufacture comprising:

- generating a small device document in a format supported by a small device from an non-record-oriented productivity document in a format supported by an office productivity server (col. 4, lines 57-67, col. 5. lines 26-47, col. 6, lines 47-64 and col. 8, lines 1-10);
- modifying the small device document to generate a modified version of the small device document (col. 17, lines 14-34);
- determining one or more differences between the modified version of the small device document and the office productivity document (col. 8, lines 35-47); and
- merging the one or more differences with content of the office productivity document to generate a synchronized version of the office productivity document (col. 2, lines 49-67).

As per claims **22** and **31**, Mendez teaches wherein said determining one or more difference between the modified version of the small device document and the office productivity document comprises:

- generating a modified office productivity document in the format supported by the server from the modified version of the small device document (col. 6, lines 35-42); and
- comparing the modified office productivity document to the original non-record-oriented office productivity document to determine the one or more differences (col. 10, lines 3-17).

As per claims **23** and **32**, Mendez teaches:

- wherein said generating a small device document in a format supported by the small device from the office productivity document comprises excluding one or more formats for content of the office productivity document from the small device document (column 10 lines 39-47).

As per claims **24** and **33**, Mendez teaches:

- wherein said merging the one or more differences with content of the office productivity document to generate a synchronized version of the office productivity document comprises restoring one or more formats for content of the office productivity document excluded from the small device document (col. 17, lines 14-34).

As per claims **25** and **34**, Mendez teaches wherein said merging the one or more differences with content of the office productivity document to generate a synchronized version of the office productivity document comprises:

- determining one or more formats for content of the modified version of the small device document to be merged with the office productivity document (col. 6, lines 19-33); and
- merging the content of the modified version of the small device document into the office productivity document in accordance with the determined one or more formats for the content (col. 2, lines 49-67).

As per claims **26** and **35**, Mendez teaches wherein said merging the one or more differences with content of the office productivity document to generate a synchronized version of the office productivity document comprises:

- comparing modified content of the modified version of the small device document to corresponding content of the office productivity document to determine one or more formats for the modified content of the modified version of the small device document to be merged with the office productivity document (col. 10, lines 3-1); and

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- merging the modified content of the modified version of the small device document into the office productivity document in accordance with the determined one or more formats for the modified content (col. 2, lines 49-67).

As per claims **28** and **37**, Mendez teaches:

- wherein said modifying the small device document is performed within the small device (col. 17, lines 14-34).

As per claims 29 and 38, Mendez further teaches:

- generating a modified document in an interim format from the modified version of the small device document (col. 11, lines 19-29, col. 20, lines 60-67 and col. 22, lines 1-6);
- generating a document in the interim format from the office productivity document (col. 5, lines 45-64 and col. 6, lines 19-33);
- wherein said determining one or more formats for content of the modified version of the small device document to be merged with the office productivity document comprises determining one or more differences between the modified document in the interim format and the document in the interim format (col. 6, lines 19-33); and
- wherein said merging the content of the modified version of the small device document into the office productivity document in accordance with the determined one or more formats for the content comprises merging the determined one or more differences with content of the document in the interim format to generate a synchronized version of the document in the interim format (col. 6, lines 19-33).

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaShonda T. Jacobs whose telephone number is 571-272-4004. The examiner can normally be reached on 8:30 A.M.-5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LaShonda T Jacobs
Examiner
Art Unit 2157

ltj
January 6, 2006


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ART UNIT 2157